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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,894	03/06/2002	Tsukasa Kobayashi	15344	6289
7590	12/13/2004		EXAMINER	
Scully, Scott, Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			PANTUCK, BRADFORD C	
			ART UNIT	PAPER NUMBER
			3731	

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/091,894	KOBAYASHI ET AL.
	Examiner Bradford C Pantuck	Art Unit 3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 10/25/2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 6-23 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                                                         |                                                                             |
|---------------------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                                                    | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>04/08/04, 03/06/02</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|                                                                                                                                                         | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### *Election/Restrictions*

1. Claims 6-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on October 25, 2004.

### *Claim Objections*

2. Claim 4 is objected to because of the following informalities: in line 7, change “sail” to “said”. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claiming, “a tensile stress of the manipulating wire is always applied only to the clip located at the most distal end,” is unclear. First, examiner assumes that Applicant means to claim applying a force *equal to* the tensile stress inside the manipulating wire. Analogously, if a sailor pulls on a rope attached to a sail, the sailor will induce a tensile stress *inside of* the rope. The tensile force *inside of* the rope will be the same as the force applied to the sail. However, the sailor is not applying a “tensile stress of the rope to the sail”.

Second, Examiner contends that it is impossible for the clip to remain static if the only force on the clip is exerted by the manipulating wire. In other words, applying a force to the clip will necessarily cause an “equal and opposite” force on either another clip or the distal end of the device [Newton’s Third Law: “For every action there is an equal and opposite reaction”]. Consequently, in applying a force on the distal clip, it is impossible (with the clip being static) to have the force be only applied to the clip.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,242,456 to Nash et al. Nash discloses an apparatus for ligating tissue (24) [see Fig. 6] including all of the claimed structure. Nash discloses an introducing tube (104), a manipulating wire (“tether 36”) capable of insertion into the tube, two or more clips (20), connecting member (“knot 140”) [see Fig. 6]. Wire (36) applies a force only to the distal clip (20) [see Fig. 6; Column 9, lines 55-65]. Clarifying the manipulating wire’s (“tether 36”) capability of being inserted into the tube (104), with reference to Fig. 3, the wire is almost inside of the tube in the illustrated Figure and would certainly be capable of being pushed a bit further to be inside of the tube.
5. Regarding Claim 2, the other clips are capable of freely moving on the manipulating wire (36), particularly as shown in Figures 9 and 10.

6. Regarding Claim 3, connecting member (“knot 140”) [see Fig. 6], being a knot certainly has at least one loop.
7. Regarding Claim 4, ring (34) is mounted to each arm and closes the pinch section of the clip (distal portion of each arm). The ring’s proximal edge is an engaging means that is capable of preventing the clip to go back into the tube (particularly if the clip is rotated a little bit).
8. Regarding Claim 5, the connecting member (140) appears to have a smaller diameter than the wire (36) [see Figures 3-6].

*Conclusion*

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U.S. Patent No. 6,814,742 to B2 to Kimura et al.

U.S. Patent No. 5,207,692 to Kraus et al.

U.S. Patent No. 5,174,276 to Crockard

U.S. Patent No. 5,100,418 to Yoon et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (571) 272-4701. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3731

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*BCP*  
BCP

December 1, 2004

ANHTUAN T. NGUYEN  
PRIMARY EXAMINER

*12/8/04*